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09/382,371	08/24/1999	JEFFRY JOVAN PHILYAW	PHLY-24.737	5132

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EXAMINER

NGUYEN, HAI V

ART UNIT	PAPER NUMBER
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2142

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/382,371

Applicant(s)

PHILYAW ET AL.

Examiner

Hai V. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-17 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to the communication received on 09 November 2006.
2. Claims 1-17 are presented for examination.

Response to Arguments

3. Applicant's arguments and amendments see Applicant's remarks, pages 9-11, received on 09 November 2006, with respect to the rejection(s) of claim(s) 1, 14 under Rejection 35 USC 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Wang et al. US patent application publication # US 2002/0042736 A1.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
6. While the specification describes in figure 19 that, *"This message from the PC 302 is transmitted over a path 1900 to the ARS 308 where the ARS database 310 is*

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accessed to cross reference the ID information 1804 and bar code information 1802 to a particular advertiser and wand distributor. The ARS 308 returns a message packet over a path 1902 to the user PC 302 which contains routing information as to the location of various other sites disposed on the GCN 306, for example, the advertiser server 312 and wand distributor site 1616. It is noted that, when the wand (or tool) is utilized, the program at the PC may recognize this and merely input the user ID in the want (or tool) ID field" (specification, page 42), the amended claims 1, 14 describe the limitation that "receiving from the intermediate node on the network instructional code that was generated at the intermediate location as a result of the transmission of the data transmission thereto, which instructional code includes routing information that instructs the user location to connect to one of the plurality of destination locations on the network that has a defined association with the representation of the unique information defined in a database at the intermediate location on the network, which defined associated is required to provide for unique information to be associated with the one of the plurality of destinations on the network and without which the unique information can not be associated with one of the plurality of destination locations on the network, and which defined association is defined by the intermediate location and can be changed at the intermediate location and in the possession of the intermediate location".

It is clearly that the database, as described in specification, is utilized for cross referencing the ID information 1804 and the bar code information 1802 to a particular advertiser and wand distributor. The specification does not describe clearly how "a database having the defined association required to provide for the unique information

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to be associated with the one of the plurality of destinations locations on the network and without which the unique information can not be associated with one of the plurality of destination locations on the network, and which defined association is defined by the intermediate location and can be changed at the intermediate location and in the possession of the intermediate location" can be done?.

7. Claims 4, 7 contain the negative limitation.

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(e) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by **Wang** et al. US patent application publication # **US 2002/0042736 A1**.

10. As to claim 1, Wang, Universal Product Information Lookup and Display System, discloses a method for interconnecting a user's location (*Figs. 1, 4, client 10*) on a network (*WAN or Internet*) to a select one of a plurality of destination locations (*Fig. 1, server product information 28, 30*) on the network, comprising the steps of:

receiving unique information (*Fig. 2, box 66, obtaining UPC bar code #*) at the user's location (*Fig. 4*) before being connected to the network (*Fig. 2, box 68*);

assembling a data transmission (*TCP/IP packet information*) containing a representation of the unique information (*Fig. 3, the UPC code or UPC identifier 110*);

transmitting the data transmission to an intermediate node (*Fig. 1, a MSP 64, [0030]*) on the network having associated therewith a database (*mapping program database, [0030]*);

receiving from the intermediate node on the network instructional code (*the mapping function or program*) that was generated at the intermediate location as a

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result of the transmission of the data transmission thereto, which instructional code includes routing information (*an HTML page information including a link to the web site address which contains the desired product information [0032]*) that instructs the user location to connect to one of the plurality of destination locations (*Fig. 1, servers 28, 30*) on the network that has a defined association (*a mapped corresponding relationship*) with the representation of the unique information (*Fig. 5, package indicia 120*) defined in a database (*Fig. 5, mapping program database, [0030], [0036]-[0039]*) at the intermediate location on the network (*Figs. 2, 5, step 74, [0030], [0036]-[0039]*), which defined associated is required to provide for unique information to be associated with the one of the plurality of destinations on the network and without which the unique information can not be associated with one of the plurality of destination locations on the network, and which defined association is defined by the intermediate location and can be changed (*not only one-to-one correspondence between product codes and web site information but also having more than one product code will correspond to a single web site, [0037]*) at the intermediate location and in the possession of the intermediate location (*Figs. 1, 5, mapping program database provided by the MSP 64, [0030], [0036]-[0039]*).

Interconnecting (*Fig. 2, steps 76, 78*), in response to the step of receiving from the intermediate location on the network instructional code and without any intervention at the user location (*automatically executed, [0032]*), the user's location to the one of the plurality of destination locations across the network in accordance with the network routing information and accordance with the received instructional code such that

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connection to the one of the plurality of destination locations is controlled by the intermediate location in accordance with the defined association between the representation of the unique information received at the user location and the routing information to the one of the plurality of destination locations on the network (*Fig. 5, [0036]-[0039]*).

11. As to claim 2, Wang discloses the network comprises a global communication network (*Fig. 4, WAN or Internet 100*).

12. As to claim 3, Wang discloses the step of receiving the unique information comprises receiving machine-readable code having unique information embedded therein (*Fig. 4, user scans product code 110 by the bar code reader 16, [0031]*).

13. As to claim 4, Wang discloses the step of receiving the machine readable code comprises scanning the machine readable code, decoding the machine readable code and outputting the information encoded within the machine readable code as the representation of the unique information (*Fig. 4, user scans product code 110*).

14. As to claims 5-8, Wang discloses the number or other identifiers, which are machine-readable code. Therefore, the product code, barcode, ISBN number and EAN code are merely the numbers or identifiers, which are machine-readable code (*Fig. 4, user scans product code 110*).

15. As to claim 9, Wang discloses, the step of receiving from the one of the plurality of destination locations at the user location display information generated by the one of the plurality of destination locations which is displayed to a user at the user location

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after interconnection to the one of the plurality of destination locations by the step of interconnecting (*Fig. 2, 3, 4, [0030]-[0034]*).

16. As to claim 10, Wang discloses the step of receiving from the intermediate location on the network instructional code comprises:

comparing (*matching, translating*) the received representation of unique information at the intermediate location with a database of routing information, which database of routing information includes a plurality of associative relationships between predetermined representations of unique information and locations of various ones of the plurality of destination locations (*Fig. 5, 126a-126n*) on the network (*Fig. 5, a mapping program database, [0030], [0036]-[0039]*) and

if an association (*correspondence*) between the received representation of unique information and routing information on any of a plurality of destination locations on the network exists within the database, returning the associated routing information as part of instructional code back to the user location for effecting a network connection to the one of the plurality of destination locations indicated by the routing information in the step of interconnecting (*Figs. 2-4, [0031]-[0034]*).

17. As to claim 11, Wang discloses, wherein the step of interconnecting includes the step of activating a web browser program which facilitates the interconnection over the network in response to receiving the instructional code including the routing information, which web browser program is operable to at least provide the interconnection of the user location to the destination location in accordance with the associated routing information under control of the intermediate location (*Figs. 2, 3, [0031]-[0033]*).

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18. As to claim 12, Wang discloses, wherein the step of assembling a data transmission comprises assembling a message packet containing a representation of the unique information (*UPC code or identifier(s)*).

19. As to claim 13, Wang discloses, wherein the step of assembling the message packet (*the TCP/IP packet information*) comprises forming a data transmission that is comprised of a first field having associated therewith source information as to the location on the network of the user location, a second field having associated therewith destination information as to the location of the intermediate node on the network and a third field having associated therewith the representation of the unique information (*the UPC code field, [0031]-[0032]*).

20. Claim 14 is similar limitations of claim 1; therefore, it is rejected under the same rationale as in claim 1.

21. Claims 15-17 are similar limitations of claims 4, 9, 10; therefore, they are rejected under the same rationale as in claims 4, 9, 10.

22. Further references of interest are cited on Form PTO-892, which is an attachment to this action.

23. Further references of interest are cited on Form PTO-892, which is an attachment to this action.

Conclusion

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai V. Nguyen whose telephone number is 571-272-3901. The examiner can normally be reached on 6:00-3:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hai V. Nguyen
Examiner
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HV



ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER